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IN THE

Supreme Court of the United States.

No. 709. October Term, 1933.

EASTMAN KODAK COMPANY, EASTMAN KODAK COMPANY OF NEW YORK AND EASTMAN KODAK STORES, INC.,

Petitioners,

v.

CHARLES B. GRAY,

Respondent.

BRIEF FOR RESPONDENT.

STATEMENT OF THE CASE.

This is an action at law for infringement of a patent for a "power transmitting mechanism" or "cable release" for actuating the shutter of a camera.

The patent in suit, number 1,314,867 (R., Vol. II, p. 206) was granted September 2, 1919, to respondent Charles B. Gray, upon an application filed February 7, 1918.

Petitioners are engaged in the manufacture and sale of cameras and camera equipment and accessories of all kinds.

The statement of claim alleged that petitioners were manufacturing and selling the cable release which was covered by respondent's patent. The defenses were that

the claims of the patent were invalid and certain of them were not infringed.

The case was first tried before Judge Dickinson and a jury. Certain of the facts were agreed to by stipulation (R., pp. 20-22, 118). Witnesses were examined by both parties and a large number of exhibits were introduced in evidence. There was no conflict in the testimony.

The court submitted the case to the jury (R., p. 118) which found a verdict in favor of respondent (R., p. 148). Petitioners moved for a new trial, which Judge Dickinson granted on the sole ground that upon examining the charge he found it to be "wholly inadequate and the jury lacked the instructions which should have been given" (R., p. 149).

The facts being entirely undisputed, the parties agreed to waive a trial by jury and to submit the case to another Judge of the District Court "for decision upon the record already made" (R., p. 149), and further stipulated "that all motions made by either party at the said trial (before Judge Dickinson) shall be deemed to have been made before the Judge trying the case, both parties to have the right of appeal as in other cases" (R., pp. 149-150).

Pursuant to the stipulation, the parties appeared before Judge Kirkpatrick in the District Court, and argued the case on the record already made, no witnesses being examined or evidence produced; each party requested the entry of judgment in his favor.

In due course, the said Judge filed his opinion, in which he recited the facts, expressed his views on certain legal points, and made an order that judgment should be entered for petitioners.

Thereupon, the respondent duly took exceptions "to the rulings, opinion and action of the said Court", and the seal of the Judge was affixed thereto (R., p. 156).

Thereafter, and within the proper time, respondent filed his petition for appeal to the Circuit Court of Appeals for the Third Circuit. An order allowing the appeal was made and the assignments of error were filed on August 15, 1932.

On December 9, 1932, petitioners submitted to the Court of Appeals a motion to dismiss the case, on the ground that the record presented no question properly reviewable by that Court (R., p. 164). The statement in the brief of petitioners in this Court (p. 6) that "decision on the motion was postponed until final hearing" is inadvertent, as the motion was not presented to the court until December 9, 1932, the day the case was actually argued (R., pp. 164-165).

On August 22, 1933, the Court of Appeals filed its opinion and decision, holding that the admitted and undisputed facts shown by the record submitted to Judge Kirkpatrick did not support his judgment, reversed the case and granted respondent a new trial (R., pp. 165-180).

Petitioners filed a petition for rehearing, which was in due course denied, and thereafter, without waiting for further proceedings in the court below, petitioned this Court for a certiorari, which was granted.

SUMMARY OF ARGUMENT.

1. The Court of Appeals Had Power to Review the Record of the District Court, to Determine Whether the Facts Shown by the Stipulated Record Supported the Judgment.

(a) The Court of Appeals did not reverse the judgment of the District Court on the ground that the evidence did not support its findings, but on the ground that the undisputed facts did not support the judgment.

(b) Where the facts which are the basis of the court's judgment are agreed to or established by undisputed evidence, the question whether the judgment is supported by those facts is always open to review by a court of appeals, whether or not a motion for judgment was made at the trial.

(c) The facts shown by the stipulated record upon which the District Court based its judgment were all either agreed to by the parties or established by undisputed evidence.

(d) Petitioners requested the District Court to rule on the question of invention as a matter of law and cannot now argue that such ruling was a finding of fact not open to review.

(e) Respondent made a motion for judgment in his favor upon the stipulated record which under any theory of the case enabled that record to be brought before the Court of Appeals for review.

2. **The Writ of Certiorari Should Be Dismissed Without Examination Into the Merits of the Case Because the Reasons for Granting the Writ Alleged in the Petition Have Been Shown to Have No Existence.**

3. **The Facts Shown by the Stipulated Record, All of Which Were Agreed Upon or Established by Undisputed Evidence, Do Not Support the Judgment Which Was Entered by the District Court, and the Court of Appeals Properly Reversed That Judgment and Granted a New Trial.**

   (a) The combination of an open coil spring casing, with a closed coil plunger—admittedly novel—involved invention and the patent was properly held valid by the Court of Appeals.

   (b) Claims 1 and 2 of the patent are properly interpreted as calling for a closed coil plunger.

   (c) Nothing occurred in the Patent Office which prevents respondent from so reading these claims; there was no estoppel and no abandonment of this essential feature of the invention.

4. **The Contention Made in Petitioners' Brief, That They Had Conceived of Respondent's Device Before He Disclosed It to Them Is Immaterial to This Appeal, But the Admitted Facts Do Not Sustain This Conclusion.**

ARGUMENT.

1. THE COURT OF APPEALS HAD POWER TO REVIEW THE RECORD OF THE DISTRICT COURT, TO DETERMINE WHETHER THE FACTS SHOWN BY THE STIPULATED RECORD SUPPORTED THE JUDGMENT.

(a) The Court of Appeals did not reverse the judgment of the District Court on the ground that the evidence did not support its findings, but on the ground that the undisputed facts did not support the judgment.

Petitioners, in their brief, have sought to convey the impression that the Court of Appeals reviewed conflicting evidence in the court below, and, on the theory that the facts found were not sustained by the evidence, reversed the case. Thus, in their brief, page 6, petitioners assert that the Circuit Court of Appeals held

> "that the evidence did not support the findings made by the trial judge but required contrary findings leading to the conclusion that the patent was valid and infringed".

And in their specification of errors it is alleged that the Circuit Court of Appeals erred

> "2. In holding that the evidence did not support the findings challenged on appeal by respondent's assignment of errors but required contrary findings leading to the conclusion that the patent in suit was valid and infringed."
>
> (Petitioners' Brief, p. 7.)

Other statements of like character, apparently intended to convey the impression that this is what the Court did, are to be found on pages 7, 8, 10, 13, 23, and at other points in the petitioners' brief.

These statements are incorrect and convey an erroeous impression. The following excerpts from the opinion of the Circuit Court of Appeals make this clear:

> " . . . In substance, the trial was a quasi demurrer. No witnesses were examined. On final hearing neither party asked for any special findings of fact, for there were no disputed facts." (R., p. 165.)

> "We here again note—for it cannot be too strongly stated—that in this case there were no disputed facts." (R., p. 172.)

> " . . . In the proceedings in the patent office, there were, as is here the case, no disputed facts." (R., p. 174.)

> " . . . There being no question as to the facts, the Court below was confronted with the legal question of whether the making of the combination, which was novel and useful also, involved invention." (R., p. 174.)

> "It will be observed that there is, and was, no dispute as to facts. No terms of art were involved. The specification was self-explanatory. The elements were all old. No issues of fact were raised." (R., p. 177.)

> ". . . Had the present case been tried with a jury, it is clear that with no issue of fact involved, with the presumption of validity created by the grant of the patent, with the affirmative testimony of defendant's witness Christie showing gained flexibility, with no contradictory testimony whatever, it would have been the duty of the court to instruct the jury the patent was valid and infringed. That jury trial was waived in no way

changed this question of law into one of fact or prevents this Court from reviewing the action of the trial Judge in holding this patent invalid." (R., p. 179.)

The record fully sustains the Court of Appeals in these statements; our object in quoting them is to demonstrate the inaccuracy of the many statements contained in the petitioners' brief, asserting that the Court of Appeals reviewed the evidence and found that it did not support findings of fact made by the court below.

What the Court of Appeals did was quite different. It reviewed the record and found that the judgment of the district court was not supported by the undisputed facts shown by the stipulated record.

(b) Where the facts which are the basis of the court's judgment are agreed to or established by undisputed evidence, the question whether the judgment is supported by those facts is always open to review by a court of appeals, whether or not a motion for judgment was made at the trial.

It is well settled that where the facts, which are the basis of the judgment of a court trying a case without a jury, are agreed to or established by undisputed evidence the record may be reviewed by the Court of Appeals to determine whether the judgment is supported by the admitted facts.

Supervisors v. Kennicott, 103 U. S. 554. This case was tried by a judge without a jury in the District Court on an agreed statement of underlying facts. The trial judge made a general finding for the plaintiff and entered judgment in his favor. The plaintiff upon appeal contended that there was nothing which could be re-examined by this Court, for

the same reasons urged in the case at bar, there being a general finding for the plaintiff. This Court rejected the argument, holding that, in view of the fact that the judgment was based on agreed facts, "There was no issue but of law, and that the court found for the plaintiffs. The same case is brought here by the record, and we are entirely satisfied it is one we have the power to review" (p. 557), thereupon reversing the judgment.

It is also well settled that even though all the facts are not agreed to, if they are proven by evidence which is admitted to be uncontradicted, the case is treated as one of an agreed statement of facts, and the question whether these facts support the judgment is open for review. This is well illustrated by the case of *Insurance Co. v. Tweed*, 7 Wall. 44, in which this Court had under consideration its right to review the judgment of a trial court sitting without a jury. The case had not been submitted upon an agreed statement of facts, but counsel for both parties had agreed that certain parts of the opinion of the trial judge contained the material facts of the case. This Court assumed jurisdiction to review the judgment, saying (p. 51):

> "We are asked in the present case to accept the opinion of the court below, as a sufficient finding of the facts within the statute, and within the general rule on this subject. But with no aid outside the record we cannot do this. The opinion only recites some parts of the testimony by way of comment in support of the judgment, and is liable to the objection often referred to in this court, that it states the evidence and not the facts as found from that evidence. Besides, it does not profess to be a statement of facts, but is very correctly called in the transcript, 'reasons for judgment.'
>
> "But the counsel for both parties in this court have agreed to certain parts of that opinion as containing

the material facts of the case, and to treat them here as facts found by the court; and inasmuch as they could have made such an agreement in the court below, we have concluded to act upon it here as if it had been so made."

The rule of *Insurance Co. v. Tweed* was approved by this Court in *Lehnen v. Dickson*, 148 U. S. 71.

Other cases in this Court recognizing the rule of *Supervisors v. Kennicott* are *United States Trust Co. v. New Mexico*, 183 U. S. 535, *Wilson v. Merchants Loan & Trust Co.*, 183 U. S. 121.

Cases in Circuit Courts of Appeals sustaining the same principles and holding that an agreement as to facts either formal or informal presents a case reviewable by an appellate court to ascertain whether the facts sustain the judgment are the following:

United States v. Smith, 39 F. (2d) 851 (First Circuit); *Southern Railway Company v. Atlantic National Bank*, 112 Fed. 861, certiorari denied 184 U. S. 700 (Fifth Circuit); *Philadelphia Casualty Co. v. Fechheimer*, 220 Fed. 401 (Sixth Circuit); *Mayes v. Paul Jones Co.*, 270 Fed. 121 (Sixth Circuit); *Union Wire Rope Corp. v. Atchison etc. Ry. Co.*, 66 F. (2d) 965, certiorari denied 54 S. Ct. 122, 78 L. Ed. 114 (Eighth Circuit); *Order of United Comm. Travelers v. Shane*, 64 F. (2d) 55 (Eighth Circuit); *Perry v. Wiggins*, 57 F. (2d) 622, certiorari denied 287 U. S. 609 (Eighth Circuit); *Kirkman v. Farmers Savings Bank*, 28 F. (2d) 857 (Eighth Circuit); *Lumbermen's Trust Co. v. Ryegate*, 61 F. (2d) 14 (Ninth Circuit); *Greer-Robbins Co. v. United States*, 19 F. (2d) 841 (Ninth Circuit); *U. S. Fidelity & Guaranty Co. v. Wyer*, 60 F. (2d) 856, certiorari

denied 287 U. S. 647 (Tenth Circuit); *White v. United States,* 48 F. (2d) 178 (Tenth Circuit).

The principle announced by these cases is succinctly expressed in *Kirkman v. Farmers Savings Bank,* supra, 28 F. (2d) at pages 860-861, as follows:

> "When a case is tried upon an agreed stipulation of facts, the question whether the facts are sufficient to support the judgment is open to review on writ of error, though neither a finding nor declaration of law are requested. Hipple v. Bates County, 223 F. 22 (C. C. A. 8); certiorari denied 241 U. S. 672, 36 S. Ct. 723, 60 L. Ed. 1231; Lehnen v. Dickson, 148 U. S. 71, 73, 13 S. Ct. 481, 37 L. Ed. 373; Wayne County v. Kennicott, 103 U. S. 554, 26 L. Ed. 486; Blair v. United States (C. C. A.), 241 F. 217, 230; Mutual Life Ins. Co. v. Kelly, 114 F. 268 (C. C. A. 8)."

(c) The facts shown by the stipulated record upon which the District Court based its judgment were all either agreed to by the parties or established by undisputed evidence.

The decision and judgment of the district judge was based upon a record which was submitted to him by stipulation for his decision (R., p. 149), "both parties to have the right of appeal as in other cases" (R., p. 150). The argument before that court is referred to as a trial, but in fact it was not a trial; no witnesses were examined and no evidence taken. The record so submitted to the district judge was made up of stipulations (R., pp. 20-22, 118) and many exhibits, patents, samples of releases, etc., which had been offered at the first trial. It also consisted of the testimony of witnesses called by both sides, but there was no contradiction in the testimony.

It is expressly admitted by petitioners that the facts shown by that record are undisputed, at least so far as relates to any issue which came before the Court of Appeals, and that it supplied the district judge with all facts necessary to decide the validity of the patent. Thus, in their brief (p. 22) petitioners say there was no conflict in the testimony

> "relating to the prior art, the inventions described in earlier patents, and the nature of the accused devices."

And in the petition for certiorari (p. 20) petitioners assert:

> "In the instant case the evidence fully established the nature of the alleged improvement, the nature of the devices found in the prior art, and the differences in structure and operation between the alleged improvement and the prior art devices."

In their brief in this Court, the principles above advanced by respondent are assented to by petitioners as applied to this case (pp. 21-22), but the argument is made that the said record did not include *all* the facts necessary for the decision of the Court; that

> "The ultimate facts going to make up the plaintiff's alleged cause of action and defendants' grounds of defense—invention, novelty, and infringement—remained for determination by the trial judge, who decided them in favor of the defendants": (Petitioners' Brief, p. 22).

This requires an examination to determine whether these three defenses—invention, novelty and infringement—did remain, as alleged, for determination by the trial judge **as facts**, and were decided in favor of petitioners.

We will first consider the question of infringement. Claims 1 and 2 of the patent are the only ones remaining

in the case; they were the only ones dealt with by the Court of Appeals. In the record appears the following statement by counsel for petitioners (R., pp. 62-63):

> "MR. DAVIS: It has already been stated in answer to your Honor's question and in the presence of the jury, that the defendant does not deny that claims 1 and 2 of the patent are infringed if they are valid."

This disposes of the argument that the question of infringement "remained for determination by the trial judge".

The next question is as to "novelty" as a defense. It is respondent's contention that claims 1 and 2 of the patent, if construed to call for a closely coiled tube as a plunger, cover a novel invention and are valid. In the district court and in the Court of Appeals petitioners contended that these claims, if so construed, were anticipated by a British patent. This claim was found against them both by the district court (R., pp. 152-153) and by the Court of Appeals (R., pp. 168-169).

It is thus clear that the finding of the District Court on the question of novelty was not, as alleged, in favor of defendants (petitioners) but on the contrary was in favor of the respondent.

This leaves only the one question of "invention", which is now claimed remained for decision by the trial judge as an "ultimate fact", upon which, it is alleged, there was a finding of fact favorable to petitioners such as to preclude a further examination by any court.

It should be noted that the question of invention was the principal issue in this case. A conclusion thereon obviously could not have been stipulated but must be left to be drawn by the court by the application of legal principles

to admitted facts. That a conclusion of this kind is not to be considered an "ultimate fact," which must be agreed upon within the ruling of *Wilson v. Merchants Loan & Trust Co.*, 183 U. S. 121, 127, cited by petitioners, is self-evident.

In *United States v. Jefferson Electric Mfg. Co.*, 78 L. Ed. Advance Opinions, p. 541, decided by this Court on February 12, 1934, it appeared that the court had tried, without a jury, a claim for a tax refund. The taxpayer had sold certain articles subject to tax for a flat price but with a notification to the purchaser that a certain fraction of the price was to cover the tax. The total price charged to the purchaser had been reduced from the price previously charged by the amount of the tax and for that reason the district court held that, while the taxpayer had collected the tax from its customers, it had returned it to them, and, therefore, was entitled to sue and recover a refund.

The Circuit Court of Appeals had reversed the judgment of the district court, on the ground that the evidence did not support the facts which it found. This Court reversed the action of the Court of Appeals, holding it

> "was not within the province of that court to re-examine the evidence and reverse the judgments because of what it regarded as errors of fact." (P. 553.)

This Court continued, however:

> "Whether the special findings give the requisite support to the judgments rendered thereon is a different question and is one which is open to consideration here." (P. 553.)

In its consideration as to whether the findings did support the judgments, it was strongly argued that the conclusion of the district court that the tax had been refunded to the purchaser by the taxpayer was a finding of fact,

which supported the judgment and by which the Court of Appeals was bound. This Court, however, rejected this view and held that such finding was

> "shown by its mere statement to be not a finding of fact but unsatisfactory reasoning having little tendency to establish its objective" (p. 554),

and that it must, therefore, be disregarded.

So, in the case at bar, we submit that the statements of the court that he "was satisfied" that the combination of elements made by respondent produced no new joint function and was unpatentable (R., p. 151), that he was "unable to see" how the arrangement of the elements made by respondent created any new functional relationship (R., p. 152), and that the combination was "not patentable" for certain reasons (R., p. 155), cannot be considered as findings of fact precluding any re-examination thereof by the Court of Appeals. They were, rather, a statement of his reasons, based on underlying and admitted facts, for the final action which he took, which, if unsatisfactory, may be disregarded.

A case in the Circuit Court of Appeals for the Eighth Circuit, which well illustrates the same point, is

Union Wire Rope Corp. v. Atchison, T. & S. F. Ry. Co., 66 F. (2d) 965, certiorari denied 54 S. Ct. 122, 78 L. Ed. 114. That case had been tried by the court without a jury and the underlying facts were stipulated or undisputed. The question involved was what tariff applied in determining a freight rate; this in turn depended upon whether the articles shipped had been manufactured or merely reworked at the point of shipment.

It appeared that steel rods had been shipped to this point and there had been made into wire rope, which in-

volved subjecting the rods to a heating process and certain chemical treatment, making them into wire, and weaving said wire into strands about a central core of manila rope.

The underlying facts as to what was done and as to the customary meaning of "re-working," etc., were established by evidence which was undisputed.

The district court, sitting without a jury, had found as a "special finding of fact" that the process above described produced a new manufactured product, consequently, it took a certain rate on reshipment. It was contended that this was a finding of fact which could not be re-examined in the court above. The Court rejected this argument and said in this connection (p. 968):

> ". . . it is sufficient to say that whether it can be said (as matter of law) that the wire and wire rope are 'new manufactured' products from the rods is not really determinative (as treated hereinafter) of the meaning of the tariff. The essence of this appeal is to test whether the real facts found support the judgment."

So, in the case at bar, the real question under discussion by the Court was whether or not respondent's invention was patentable and in reaching this conclusion he expressed the opinion on undisputed facts that no new mode of operation or functional relationship arose from putting together two well known elements. This, if not purely a question of law, which we think it is, was at least only an expression of opinion on underlying facts leading to the final conclusion of law and does not prevent the Court from examining the record to determine (as expressed in the case cited) whether the real facts support the judgment.

Petitioners argue as an abstract proposition that whether an improvement involves invention is a question of fact and, therefore, the court's conclusion on that point, although not framed as a finding of fact (see R., pp. 152-155), must be so considered and from this it is further argued that it cannot be re-examined by any reviewing court.

Even if this were correct, it would not be conclusive of this case. In the two cases above cited, the final conclusion was quite as much one of fact as the conclusion under discussion, and yet this Court held in the most recent case in which this matter has been examined that a conclusion deduced from admitted facts should be looked upon as "reasoning" which, if not satisfactory, may be disregarded.

Many questions which are ordinarily fact questions become legal questions when the underlying facts are undisputed. See, for example, *E. G. Budd Mfg. Co. v. Wilson Body Co.*, 21 F. (2d) 803 (C. C. A. 6), in which the Court said that a conclusion as to whether an improvement involved invention was a question of law where the underlying facts were undisputed. A certiorari was denied in this case: 276 U. S. 632.

Other cases clearly sustaining the same principle are

Heald v. Rice, 104 U. S. 737, 749; *United States v. Pugh,* 99 U. S. 265, 270-271; *Market Street Railway Co. v. Rowley,* 155 U. S. 621, 625; *Singer Company v. Cramer,* 192 U. S. 265, 275; *Winton v. Amos,* 255 U. S. 373, 395; *Sanitary Refrigerator Co. v. Winters,* 280 U. S. 30, 36; *Order of United Comm. Travelers v. Shane,* 64 F. (2d) 55, 57 (C. C. A. 8).

(d) Petitioners requested the District Court to rule on the question of invention as a matter of law and cannot now argue that such ruling was a finding of fact not open to review.

There is another consideration which is fatal to petitioners' argument. They themselves in the district court took the position that whether invention was involved in the improvement devised by respondent was a question of law, and requested the court so to rule. They cannot now, therefore, be heard to argue otherwise.

Petitioners submitted a number of points for charge to the court at the jury trial; among them was the following (R., p. 144):

> "25. The combination, in a cable release, of two heads, a barrel on the outer head, a coiled spring wire tube having spaced coils and being located between said heads and engaging said barrel, flexible means joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise, a stem extending slidably through one of said heads and having a limited outward movement, a slide member in the other of said heads, and means intervening said stem and said slide member from said stem to said slide member was described in Edwards' British Patent No. 5,741, of 1906, in such full, clear and exact terms, as to enable any person skilled in the art of making cable releases to make and use an invention so described without the exercise of more than mechanical skill."

Point No. 27 (R., p. 144) was substantially the same.

It is clear, therefore, that petitioners asked the court at the trial to charge the jury as a matter of law that to make and use the invention described in this point did not

require "more than mechanical skill." In other words, they asked the court to charge the jury as a matter of law that the said improvement in the art did not involve invention.

In view of the provision in the stipulation that all motions made at the first trial should "be deemed to have been made before the Judge trying the case" at the second trial, these points must be looked upon as having been presented to the District Judge who tried the case the second time for his ruling thereon.

Although that judge did not specifically answer the many points presented by petitioners, he may have been influenced, and no doubt was, by their requests and found as requested that the improvement devised by respondent did not involve invention. The District Court having so found, the cases are clear that petitioners cannot now contend that the finding was not the conclusion of law which they requested but a finding of fact which is not reviewable.

The general principle that a party cannot on appeal take a position inconsistent with that taken by him in the court below is well settled.

San Juan Light Co. v. Requena, 224 U. S. 89; *Thomas v. Taylor*, 224 U. S. 73; *Texas & Pac. Railway Co. v. Abilene Cotton Oil Co.*, 204 U. S. 426; *Osgoodby v. Talmadge*, 45 F. (2d) 696 (C. C. A. 2); *Meloon v. Davis*, 292 Fed. 82 (C. C. A. 1); *Ford Motor Co. v. Farrington*, 245 Fed. 850 (C. C. A. 9); *United States v. Kettenbach*, 208 Fed. 209 (C. C. A. 9).

In the Appellate Court a party will be restricted to his theory of the case, as evidenced in the lower court, by his requests for findings: *Moretti v. Fire Assn. of Phila.*, 265 Pa. 9, 108 Atl. 171; his reasons assigned for asking for a

non-suit; *Barnes v. Perine,* 12 N. Y. 18; his motion for a directed verdict in his favor; *West v. Newton,* 229 Mich. 68, 201 N. W. 196; *Dutcher v. Porter,* 63 Barb. 15 (N. Y.); or his express statement of the theory on which the case was tried, *American Railway Express Co. v. Mohawk Dairy Co.,* 250 Mass. 1, 144 N. E. 721.

This rule has been expressly extended to cases where in the court below a party treated a matter at issue as a question of law and attempted on appeal to reverse himself and assert the contrary. This, it was held in the cases following, could not be done.

American Railway Express Co. v. Mohawk Dairy Co., 250 Mass. 1, 144 N. E. 721; *West v. Newton,* 229 Mich. 68, 201 N. W. 196; *Barnes v. Perine,* 12 N. Y. 18; *Dutcher v. Porter* 63 Barb. 15 (N. Y.).

In *West v. Newton,* supra, both parties had moved for a directed verdict. After a verdict was directed for the plaintiff the defendants appealed, alleging that the case should have been submitted to the jury. The Court said, at page 71:

> "The defendants claim that the court erred in directing a verdict for the plaintiff, because there was an issue of fact for the jury. . . . Both parties having asked for a directed verdict, counsel cannot now complain that there was an issue of fact for the jury: *Kyselka v. Assurance Co.,* 194 Mich. 430; *Germain v. Loud,* 189 Mich. 38; *City National Bank v. Price's Estate,* 225 Mich. 200."

In *Barnes v. Perine,* supra, the defendant had moved for a non-suit, assigning three separate propositions of law in support of his motion. The motion was denied and a verdict was directed for the plaintiff. The defendant then

appealed on the ground that the case should have been submitted to the jury. The judgment was affirmed, the court saying, at page 23:

> "If the defendant supposed that there was a disputed question of fact, material to the issue between the parties, he should have made a distinct request that it should be submitted to the jury. But having treated the questions as purely legal, and acquiesced in the disposal of them by the court as such, he cannot now be heard to object that facts were involved which should have been decided by the jury."

It is therefore clear from the foregoing considerations that the record submitted by stipulation to the District Court contained all of the underlying and ultimate facts necessary to the decision, all of which were undisputed, and that the Court of Appeals had power and jurisdiction to review the entire record to ascertain whether the judgment was supported by the facts stipulated and agreed to.

(e) Respondent made a motion for judgment in his favor upon the stipulated record which under any theory of the case enabled that record to be brought before the Court of Appeals for review.

The stipulation waiving a trial by jury in this case (R., p. 149), after providing for the submission of the case to the Court on the record already made, further provided

> "all motions made by either party at the said trial [before Judge Dickinson and a jury] shall be deemed to have been made before the Judge trying the case, both parties to have the right of appeal as in other cases."

At the said previous trial the motions made by petitioners were as follows:

(1) A renewal of a previous motion to quash the writ (R., p. 76).

(2) A motion for non-suit (R., p. 76).

(3) A motion or request for instructions to the jury on various points including a motion for a directed verdict in favor of petitioners (R., pp. 135-147).

(4) A motion for a new trial and to set aside the verdict (R., p. 148).

Respondent made but one motion at the said trial, to wit: a motion for judgment on the verdict and assessment of damages. This is shown in the Record only as a docket entry. (R., p. 3, Entry of Jan. 9, 1932.)

The provision in the stipulation that the motions made by either party at the previous trial should be considered as having been made "before the Judge trying the case" obviously means that the said motions with such changes as would be appropriate by reason of the changed character of the trial should be considered as having been made at said trial. Thus petitioners' motions for quashing the writ and for nonsuit would be substantially as made. Their motion that the court instruct the jury on certain points would be treated as requests for special findings in view of the fact as remarked by Judge Taft in *Humphreys v. Third National Bank,* 75 Fed. 852, 856 (C. C. A. 6), that a court could not be expected to instruct himself on these points; their motion for binding instructions would obviously be considered as a motion for judgment in favor of petitioners upon the whole record. As petitioners' motion for a new trial was granted, it need not be considered.

As noted above, respondent made but one motion,—a motion for judgment on the verdict and assessment of dam-

ages. Applying this to the trial before Judge Kirkpatrick, it could only be construed as a motion for judgment in favor of respondent on the record submitted to that Judge and that damages be assessed.

In the Court of Appeals petitioners argued that this motion could not be so construed because it was a motion for judgment on the verdict, and it was argued that a motion for judgment on the verdict made before a judge trying a case without a jury would be meaningless.

It is submitted that this argument is unsustainable. If the term of the stipulation above quoted did not mean that the motion in question made by the respondent should be considered as having been made at the trial before Judge Kirkpatrick, it meant nothing as regards respondent, for he made no other motion.

It is therefore clear that a motion for judgment was made by plaintiff at the trial before Judge Kirkpatrick and the refusal of that motion brought the whole record before the Court of Appeals for review, as it raised the question of law whether the court under all the facts was not bound to enter judgment for the plaintiff.

Moreover, each counsel at the argument on the stipulated record, requested Judge Kirkpatrick to enter judgment in favor of his client. There was no other purpose in arguing the case before Judge Kirkpatrick. Even if there were no formal motions on the record, these requests under all the circumstances of the case should be considered as motions for judgment for plaintiff and defendant, respectively, and in reaching his conclusions the Court granted one and refused the other. Proper exceptions were taken by respondent to the action of the court and upon the admissions contained in petitioners' brief (see pp. 11, 14), this

brought the whole record before the Court of Appeals for review, irrespective of any other point.

The foregoing argument has been advanced without taking into consideration section 269 of the Judicial Code as amended by the Act of February 26, 1919, c. 48 (28 U. S. C. § 391). That act provides:

> On the hearing of any appeal, certiorari, writ of error, or motion for a new trial, in any case, civil or criminal, the court shall give judgment after an examination of the entire record before the court, without regard to technical errors, defects, or exceptions which do not affect the substantial rights of the parties.

We submit that if this act is to be applied to any case, it should be applied to the case at bar. We do not contend that the act should be construed to abolish the necessity of exceptions in cases where an exception or motion is necessary to call to the attention of the trial judge an alleged error, and afford him an opportunity of correcting it; but where, as here, the motion for judgment which petitioners allege was required to save questions involved for review, was a mere formality not necessary to direct the attention of the judge to the points at issue, it seems clear that the act should be applied. So it was held in *Muentzer v. Los Angeles Trust & Savings Bank*, 3 F. (2d) 222 (C. C. A. 7). In that case it was contended that the Court of Appeals could not review the evidence in order to determine whether it supported the finding of the trial judge because the appellant had made no motion for judgment. Said the court (p. 223):

> "But what is the purpose of a formal motion, or of an exception? It is to apprise the court of the litigant's position, that it may, in furtherance of justice,

> correct such ruling if convinced of its error. Where both parties have fully and fairly presented the evidence, as here, and argued the questions of law fully, it seems particularly appropriate that section 269 of the Judicial code should be invoked to save litigants from the consequences of an oversight by counsel."

An examination of the cases in which it was held that this section of the code does not dispense with the necessity of exceptions reveals that in the majority of those cases counsel by failing to take exceptions had either not made known their position or had not given the court an opportunity to correct the errors complained of. This section has never been construed by this Court.

It is submitted that the Court of Appeals had jurisdiction to review the record in this case.

2. THE WRIT OF CERTIORARI SHOULD BE DISMISSED WITHOUT EXAMINATION INTO THE MERITS OF THE CASE BECAUSE THE REASONS FOR GRANTING THE WRIT ALLEGED IN THE PETITION HAVE BEEN SHOWN TO HAVE NO EXISTENCE.

The petition for certiorari in this case alleged four reasons why this Court should allow the record to be brought before it. It has been shown that none of these has any foundation.

The first reason alleged (Petition p. 8) was that the Court of Appeals held, contrary to decisions of this Court, that whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is a matter of law rather than a question of fact, although the evidence was not in conflict.

It has been shown that petitioners themselves in the district court requested a finding as a matter of law that

respondent's improvement did not involve invention, and, therefore, could not reverse themselves in the Court of Appeals and allege the finding they had requested, was a finding of fact, not subject to review.

Further, it has been shown that the conclusion of the district court that the improvement made by respondent did not involve invention was merely the result of reasoning from underlying and admitted facts, and under the decisions of this Court may be disregarded in determining whether the facts found supported the judgment.

The second reason alleged for granting the writ was that the Circuit Court of Appeals had decided, in conflict with decisions of this Court, that it had power to review conclusions of law embodied in general findings made by the trial court.

The Court of Appeals made no such decision. It found that the stipulated and undisputed facts in the court below did not support the judgment which that court had entered, and in so doing its decision was in full accord with the decisions of this Court. This point is not argued in petitioners' brief.

The third reason alleged for granting the writ was that the Circuit Court of Appeals had, in conflict with decisions of this Court, decided that it had power to review the findings of the trial court to determine whether there was any evidence upon which they could be based.

The record and the opinion of the Court of Appeals so clearly demonstrates that it decided nothing of the sort that it must be assumed that counsel inadvertently advanced this reason. It has no foundation in the record.

The fourth reason alleged for the granting of the writ is that the Circuit Court of Appeals decided that the evidence in this case did not afford a basis upon which the trial

court could find that respondent's improvement did not involve invention, and that in so deciding the Circuit Court of Appeals had decided an important question of patent law, which has not been, but which should be, settled by this Court.

This reason also must have been inadvertently advanced. The Court of Appeals did not say, nor even suggest, that there were not sufficient facts in the record from which a conclusion could be reached as to whether or not respondent's improvement involved invention. The decision of the Court of Appeals was that, upon the facts admitted and agreed to, the court below was wrong in finding that there was no invention, and reversed the case for that reason.

This Court held in *Furness, Withy & Co. v. Ins. Ass'n,* 242 U. S. 430, *Houston Oil Co. v. Goodrich,* 245 U. S. 440, and in *Southern Power Co. v. Public Service Co.,* 263 U. S. 508, that where on further examination of a case it appears that no adequate reason exists for having granted a writ of certiorari it will be dismissed without examination into the merits.

A further reason for dismissing the case at this point is the total failure of petitioners to comply with the rule of this Court requiring each specification of error to be separately and particularly asserted. See *Seaboard Air Line Ry. v. Watson,* 287 U. S. 86, 91. The third assignment (the only one relating to the merits of the case), complains only that the court below erred "in reversing the judgment entered by the District Court and granting a new trial". (Petitioners' brief, pp. 6-7.) This is meaningless and fails entirely to comply with the rule.

The new and improved addition to the art which respondent contributed was **the combination of an open coiled spring tube with a closed coil spring plunger**; this provided a mechanism far superior to anything theretofore devised.

A reference to the patent shows a drawing which illustrates the mechanism in its entirety, consisting of the two springs aforesaid and certain other elements necessary to make up the completed mechanism (R., Vol. II, p. 207). In the specifications is contained the following description (R., Vol. II, p. 210):

> "This mechanism comprises two important features. One of these is the closely-wound coiled wire transmission tube, J, connected with the stem, F, and the slide member, I, whereby there may be transmission without lost motion. The other of these features is the forming of the outer coiled wire tube, C, in such manner as to permit bending the tube without material separation of the coils at the outer side of the curve, the spacing between the coils permitting the coils to approach each other on the inner side of the curve while the tube is being bent. The member, I, being free to slide, the adjacent end of the inner wire tube, J, is free to move endwise when the mechanism is being bent. In this manner, the inner tube, although closely wound, adapts itself to the bending without kinking.
>
> "Practice has shown that a mechanism of this construction may be bent an indefinite number of times without kinking or otherwise disabling the coiled wire tubes."

As correctly stated in the petition for certiorari (p. 20):

> ". . . the evidence fully established the nature of the alleged improvement, the nature of the devices found

in the prior art, and the differences in structure and operation between the alleged improvement and the prior art devices."

The question before the Court of Appeals was whether the facts thus established and undisputed supported the conclusion reached by the trial judge that the improvement devised by respondent did not involve invention.

The district court in its opinion expressed the view that the invention was not patentable, saying in substance that an open coil spring tube having been known and used with a wire plunger, and a closely coiled spring plunger having been known and used with a closely coiled spring tube, no invention was involved in putting two of these elements together in a new combination, even though by so doing a different and superior result was achieved.

The Court of Appeals rejected this reasoning and found that the admitted facts did not sustain the conclusion that there was no invention in devising the release patented by respondent. In this connection, the Court of Appeals said (R., pp. 175-177);

> "The use of a plunger or inner member of a close-wound, non-compressible spiral spring was old. Wermann used it in Germany and the defendant had used it in America, but neither of them had sleeved it in an open-wound coil. So also the use on an outer or envelope member of close-wound coil was old. It had been so used in Britain by Edwards, but he used it as an envelope around a wire plaited plunger. Now the concept of Gray was to take the two well known devices of the prior art and for the first time use them conjointly, the close-wound coil as a pusher or plunger and the open-wound coil as an envelope. What was the effect of this novel combination? Christie answers that question. By this novel union Gray got a

photographic mechanism which was so superior to prior devices that it superseded and displaced all other and has been used by over a million users who bought from the defendant. Why this almost unprecedented result? A study of the prior structures and the exhibits in the record shows that Gray has produced a device which, while it retains the pusher rigidity of a wire, has done away with kinking and has furnished a mechanism which is as soft to the touch and as flexible as the rubber device of the old one which was abandoned, and at the same time has given a non-kinking plunger that is as rigid as a stiff wire. In other words, Gray gave to the Kodak the pliable, non-kinking features of the rubber tube, while at the same time he has retained the rigidity of a metal pusher without destructive kinking. This has been done not by merely using the two different kinds of coils, but by using them in a new relation, namely, by using the close-wound coil in the only place where it can be functionally modified by the outer open-wound coil and by using the open-wound coil in the only place where it can be modified by the inner placed close-wound coil. If Gray's relative positions were changed, if his open-wound coil was placed on the inside, and his close-wound one on the outside, if both coils were close-wound, or both were open-wound coils, such changes would be fatal. It is the new, inner and outer positions and relations in which these two different kinds of coils are placed that enables the outer coil to affect the inner and the inner to affect the outer as they never had before. This fact —for such it is—of the two coils, due to their relative position, affecting each other, is so original and seemingly so non-apparent as to lead to the belief that there is a mere aggregation of non-interlocking parts. But treating it as an aggregation with no new resultant function shows how really inventive, when duly appreciated, the new combination was. It took original thought to conceive and effort to embody the concep-

tion in practice. The effect of the novel combination of the two well known types of coils would occur only to the inventive mind, for other types of mind would naturally suppose that, used conjointly, they would operate in the old way. But the outcome proved otherwise. Moreover, the union of the two—one enveloping the other—only came after attempts for years to improve cable release. Enveloping the pusher member with a spring was known. The rigidity of a close-wound coil was known. So also was the expansibility of a loose-wound coil. Yet, strange as it seems, no one, prior to Gray, thought of nesting the former inside the latter. And when Gray disclosed it, as he did when he sent one of his devices to the defendant, it was jacketed by a textile cover. The defendant evidently could not understand how the rubber-like flexibility was effected and Gray's testimony, while not of facts, has the impress of certainty when he testified: 'The cover was evidently slitted to see what was in the inside, to see the construction.' They cut it open to see by what means he did it, at once recognized its worth, discarded their then type and adopted his. Now that it has proved its worth, his device deserves judicial recognition and its infringement due money reparation. The proofs show defendants have profited largely from it."

This Court in *Loom Company v. Higgins*, 105 U. S. 580, 591, laid down the rule whereby it could be determined whether or not an improvement involved invention in the following words:

"It is further argued, however, that, supposing the devices to be sufficiently described, they do not show any invention; and that the combination set forth in the fifth claim is a mere aggregation of old devices, already well known; and therefore it is not patentable. This argument would be sound if the combination

photographic mechanism which was so superior to prior devices that it superseded and displaced all other and has been used by over a million users who bought from the defendant. Why this almost unprecedented result? A study of the prior structures and the exhibits in the record shows that Gray has produced a device which, while it retains the pusher rigidity of a wire, has done away with kinking and has furnished a mechanism which is as soft to the touch and as flexible as the rubber device of the old one which was abandoned, and at the same time has given a non-kinking plunger that is as rigid as a stiff wire. In other words, Gray gave to the Kodak the pliable, non-kinking features of the rubber tube, while at the same time he has retained the rigidity of a metal pusher without destructive kinking. This has been done not by merely using the two different kinds of coils, but by using them in a new relation, namely, by using the close-wound coil in the only place where it can be functionally modified by the outer open-wound coil and by using the open-wound coil in the only place where it can be modified by the inner placed close-wound coil. If Gray's relative positions were changed, if his open-wound coil was placed on the inside, and his close-wound one on the outside, if both coils were close-wound, or both were open-wound coils, such changes would be fatal. It is the new, inner and outer positions and relations in which these two different kinds of coils are placed that enables the outer coil to affect the inner and the inner to affect the outer as they never had before. This fact —for such it is—of the two coils, due to their relative position, affecting each other, is so original and seemingly so non-apparent as to lead to the belief that there is a mere aggregation of non-interlocking parts. But treating it as an aggregation with no new resultant function shows how really inventive, when duly appreciated, the new combination was. It took original thought to conceive and effort to embody the concep-

tion in practice. The effect of the novel combination of the two well known types of coils would occur only to the inventive mind, for other types of mind would naturally suppose that, used conjointly, they would operate in the old way. But the outcome proved otherwise. Moreover, the union of the two—one enveloping the other—only came after attempts for years to improve cable release. Enveloping the pusher member with a spring was known. The rigidity of a close-wound coil was known. So also was the expansibility of a loose-wound coil. Yet, strange as it seems, no one, prior to Gray, thought of nesting the former inside the latter. And when Gray disclosed it, as he did when he sent one of his devices to the defendant, it was jacketed by a textile cover. The defendant evidently could not understand how the rubber-like flexibility was effected and Gray's testimony, while not of facts, has the impress of certainty when he testified: 'The cover was evidently slitted to see what was in the inside, to see the construction.' They cut it open to see by what means he did it, at once recognized its worth, discarded their then type and adopted his. Now that it has proved its worth, his device deserves judicial recognition and its infringement due money reparation. The proofs show defendants have profited largely from it."

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claimed by Webster was an obvious one for attaining the advantages proposed,—one which would occur to any mechanic skilled in the art. But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skilful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice. Who *was* the first to see it, to understand its value, to give it shape and form, to bring it into notice and urge its adoption, is a question to which we shall shortly give our attention. At this point we are constrained to say that we cannot yield our assent to the argument, that the combination of the different parts or elements for attaining the object in view was so obvious as to merit no title to invention. Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit. It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention. It was certainly a new and useful result to make a loom produce fifty yards a day when it never before had produced more than forty; and we think that the combination of elements by which this was effected, even if those elements were separately known before, was invention sufficient to form the basis of a patent."

This case recognizes the rule that a combination of old elements may involve invention, if the improvement made by combining them in a different way was one which would not occur to an ordinary mechanic skilled in the art, and to determine whether or not it would so occur to an ordinary mechanic regard must be had to the question whether per-

sons skilled in the art had struggled to make the improvement in question and for a considerable period of time had failed to make it.

As well expressed in the extract from the opinion of the Court of Appeals, above quoted, the new combination of the open coil spring tube with a closed coil plunger would only occur to the inventive mind. It was not such a change as would be obvious to any mechanic skilled in the art. The device patented by petitioners, as disclosed in the Dakin patent only a few months before respondent's application was made (although unknown to him at the time), shows a stiff and unsatisfactory release, made with a closed coil tube and a closed coil plunger.

An examination of the exhibits shows that whereas a closed coil spring is very flexible, if unconfined by a jacket, it is very stiff when surrounded with a fabric jacket, as it must be when used as the sheath or tube in a cable release. On the other hand, an open coil spring so enclosed retains its flexibility. A coiled spring, however, when used as a plunger, is entirely unconfined, as it is made to pass to and fro through the tube; it, therefore, retains its flexibility even though closely coiled, as it must be to communicate endwise motion. This is simple enough to see now but that it was not obvious to any skilled mechanic is apparent from a consideration of the history of the art.

We invite the attention of the Court to the German patent to Wermann of 1902, one of petitioners' exhibits (R., Vol. II, p. 332). This shows a combination of a closed coil plunger with a closed coil spring tube but no jacket.

The next step in the art was by Edwards and Watson, as disclosed by patents granted in 1905 and 1906 (R., Vol. II, pp. 288, 302, 309 and 322). In the earliest Edwards and Watson patents of 1905 (R., Vol. II, pp. 302, 309 and 322)

it appears that the inventors had taken a step forward in devising an open coil spring tube but they used it with a straight or stranded wire plunger, not conceiving that it would be operative with a closed coil spring as a plunger although the Wermann patent was before them. In the specifications in one of these patents, the inventors almost hit upon the combination afterwards disclosed by respondent, but failed to reach it.

In the latest patent which Edwards obtained (1906, R., Vol. II, p. 288) the same structure is shown and those portions of the specifications which petitioners argued in the district court were an anticipation of respondent's device are entirely omitted, showing that the idea which he so nearly grasped had entirely escaped him.

The next patent shown in the record is Duryea, 1913 (R., Vol. II, p. 295). The structure shown is the same as in the Edwards patent, to wit: a closed coil spring tube and a wire plunger with certain alleged improvements. With both Wermann and Edwards before him, including the specifications petitioners rely upon, he did not conceive of respondent's device.

Finally we come to the Dakin patent, developed by an employee of the petitioners immediately prior to respondent's filing date (R., Vol. II, p. 299). This release shows a closed coil spring tube and closed coil plunger. This was a return to the Wermann idea with certain improvements. There is no question that petitioners' patent attorneys had before them at this time the Edwards patents and the Wermann patent and many others, including the specifications which petitioners argued in the district court anticipate respondent's patent. There is no question that the entire purpose of their efforts was to secure a more flexible release (Christy, R., p. 106).

There is no question that respondent's release which they afterwards adopted when he disclosed it to them was better than the Dakin release, yet they patented (Dakin being an employee of petitioners) and made the Dakin release until respondent's disclosure.

In view of these facts it is idle for petitioners to argue that the combination which respondent made for the first time was only such as an ordinary skilled mechanic could have devised without the use of invention. **If it were so, why had they not discovered it?**

Many inventors, including petitioners' staff, had been working on the problem for many years and had failed to solve it. The fact that it seems simple now that it has been disclosed is no answer to the claim of invention.

The language of this Court in *Diamond Rubber Company v. Consolidated Rubber Tire Company,* 220 U. S. 428, 434, is applicable to this case:

> ". . . It [the invention] possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result', it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' . . . Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention.

But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration."

". . . And we may say in passing the elements of a combination may be all old. In making a combination the inventor has the whole field of mechanics to draw from. *Leeds and Catlin v. Victor Talking Mach. Co.*, 213 U. S. at page 318." (P. 443.)

In *The Barbed Wire Patent*, 143 U. S. 275, it appeared that the improvement covered by the patent in suit was nothing more than a slightly different method of attaching a barb to a wire fence, but this difference, slight as it was, made the fence a commercial success. It was claimed that the elements were all old, and the slightly different arrangement of the barb did not involve invention. This Court in that connection used the following language (pp. 282-283):

"Under such circumstances courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents it is the last step that wins. It may be strange that, considering the important results obtained by Kelly in his patent, it did not occur to him to substitute a coiled wire in place of the diamond shape prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of a series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp."

Thereupon quoting with approval from *Loom Company v. Higgins*, above cited.

The Court of Appeals referred to the fact that the defense of lack of invention was evidently an after-thought, as it had not been relied upon at the trial before Judge Dickinson, reciting the following from Judge Dickinson's charge (R., p. 124):

> "I have called your attention to these three elements—invention, utility, novelty. Invention, as I understand it, is not in real controversy here. So, you need not trouble yourselves about it."

Petitioners criticize this statement (Petitioners' Brief, p. 45) because, as they point out, they raised this question in points for charge. The fact is, however, that no reference was made to this defense at the trial before Judge Dickinson, and this is indicated by his statement to the jury. Further, the statement which he made was one of fact, namely, that invention was not in controversy. If this was an erroneous statement of fact, it was the duty of petitioners to have requested the court to correct it.

An examination of the record (R., pp. 131-135) shows that while counsel for petitioners requested the court to make certain corrections and additions to his charge, nothing whatever was said in reference to this point. It was, therefore, accepted by counsel for petitioners as correct, as in fact it was.

It is no answer to say that in their numerous points for charge, they had raised this point and considered the charge a denial of the points to which they took exceptions. The statement by the court was, as a matter of fact, that this point was not in controversy. As no move was made to ask the court to correct the statement as erroneous, its accuracy cannot now be questioned.

The fact that petitioners did not raise the defense of lack of invention at the first trial is a strong indication

that they did not consider it sufficiently persuasive to rely upon and only brought it in as an after-thought, when other defenses appeared under the evidence to be invalid.

It is respectfully submitted that the Court of Appeals was correct in finding that the facts did not support the conclusion of the district court that no invention was involved in devising the improvement which was the subject matter of respondent's patent.

(b) Claims 1 and 2 of the Patent Are Properly Interpreted as Calling for a Closed Coil Plunger.

Passing from the question of alleged lack of invention (the only point of a meritorious nature urged by petitioners, from beginning to end of this case) petitioners pass to certain technical defenses which they allege render claims 1 and 2 of the patent invalid.

The first is that, although the claims in the patent, and the specifications to which they refer, plainly and unmistakeably describe the invention of the patentee, respondent should not be allowed to interpret claims 1 and 2 by reference to the specifications.

Claims 1 and 2 define the plunger in general terms, with a reference to the specifications for a more complete description, and it is this description which petitioners argue should not be read into claims 1 and 2, and if not so read it is argued that these claims are anticipated by earlier patents.

Claim 1 of the patent reads as follows (R., Vol. II, p. 210):

> "1. In a mechanism of the nature described, the combination of two heads, a barrel on the outer head, a coiled spring wire tube having spaced coils and being located between said heads and engaging said

barrel, flexible means joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise, a stem extending slidably through one of said heads and having limited outward movement, a slide member in the other of said heads, and means intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member, substantially as described."

Claim 2 for purposes of this discussion is identical. It may be conceded that these claims would be anticipated by earlier patents, were it not for the incorporation therein of the description contained in the specification of the

"means intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member."

The specifications contain the following (R., Vol. II, p. 210):

"This mechanism comprises two important features. One of these is the closely-wound coiled wire transmission tube, J, connected with the stem, F, and the slide member, I, whereby there may be transmission without lost motion. The other of these features is the forming of the outer coiled wire tube, C, in such manner as to permit bending the tube without material separation of the coils at the outer side of the curve, the spacing between the coils permitting the coils to approach each other on the inner side of the curve while the tube is being bent. The member, I, being free to slide, the adjacent end of the inner wire tube, J, is free to move endwise when the mechanism is being bent. In this manner, the inner tube, although closely-wound, adapts itself to the bending without kinking.

"Practice has shown that a mechanism of this construction may be bent an indefinite number of times

without kinking or otherwise disabling the coiled wire tubes."

A reference to the drawing shows very clearly the construction of this plunger which is the only one mentioned or described in the specifications, to wit, a closely coiled wire tube of a smaller diameter than the open coiled tube surrounding it and through which it operates.

This patent, having been issued on September 2, 1919, follows the older practice whereby the claims refer to the specification for a precise description of the element considered most important, in this case, the inner tube, forming the plunger.

That the claims should be read to include therein this precise description, thereby rendering them valid, is fully sustained by authority. It has been held in many cases that the expression "substantially as described" refers back to the specification for qualification of the claim in which it appears. Thus, in *Seymour v. Osborne,* 11 Wall. 516, 547, this Court said:

> "Founded, as the defence is, upon an obvious misconstruction of the claims of the several patents, it does not seem to require much explanation. Omit the words 'substantially as described,' or 'substantially as set forth,' and the question presented would be a very different one, but inasmuch as those words, or words of equivalent import, are employed in each of the claims, the defence is without merit. Where the claim immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way."

In *The Corn-Planter Patent,* 23 Wall. 181, 218, this Court held that Reissue Patent No. 1036 was valid and infringed on the theory that the last clause of the claim "substantially as and for the purpose set forth" referred back to the specification for qualification of the claim and the several elements of which the combination was composed.

In *Westinghouse v. Boyden Power Brake Co.,* 170 U. S. 537, the Court said (p. 558):

> "There are two other facts which have a strong bearing in the same connection, and preclude the idea that this can be interpreted as a claim for a function, without reading into it the particular device described in the specification.
>
> "One of these is that the claim is for a triple-valve device, etc., for admitting air from the main air-pipe to the brake-cylinder, 'substantially as set forth.' These words have been uniformly held by us to import into the claim the particulars of the specification, or, as was said in *Seymour v. Osborne,* 11 Wall. 516, 547, 'where the claim immediately follows the description of the invention, it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specifications, it cannot properly be construed in any other way.' In that case it was held that a claim which might otherwise be bad, as covering a function or result, when containing the words 'substantially as described,' should be construed in connection with the specification, and when so construed was held to be valid. To the same effect is *The Corn Planter Patent,* 23 Wall. 181, 218."

This principle has been reaffirmed in *Hobbs v. Beach,* 180 U. S. 383, 400; *Singer Company v. Cramer,* 192 U. S.

265, 284; and *Eibel Process Co. v. Minnesota, etc., Paper Co.*, 261 U. S. 45, 70, wherein the Court held:

> "Their new adjustment is part of a new combination and the words substantially as described limit them to a combination including the elements included in the first three claims."

The effect of this was to transfer limitations appearing in the first three claims of the patent involved in the suit to claims 7 and 8 because these latter claims included the expression "substantially as described."

In the quite recent case of *Smokador Mfg. Co. v. Tubular Products Co.*, 31 F. (2d) 255, 256, 257, the Circuit Court of Appeals (2d Circuit) said:

> "'In United States patent No. 1,364,892, to Schulte & Weite, there is shown an ash tray, a tube descending to a waste receptacle at the base, which is enveloped by a skirt attached to the lower end of the tube. In the Schulte & Weite device, the ashes are emptied by a shutter in the bottom of the base, operated by a wire running down to the shutter from the top of the stand. It seems evident that the slight variations of the patent in suit from the prior structures do not merit a patent, unless the waste receptacle be limited to one composed of glass.
>
> "But the glass construction disclosed in the specification has manifest advantages. It renders the contents of the receptacle at once visible, without removal of the jar. In other words, a porter in a hotel can turn up the stand and see through the transparent glass whether any tobacco refuse is in the receptacle. If none is visible, he need not unscrew the jar, as he would have to do in the case of a stand that had not a transparent receptacle. The device manifestly saves time and labor. Moreover, a frangible substance like

glass would not, we think, readily suggest itself for a receptacle, and such a substance never seems to have been used for the purpose prior to the time when Fleming embodied the idea in the patent in suit. Indeed, the first thought of such a receptacle might well have been negatived by the consideration that glass would expose to view the dirty contents of receptacles in stands that had been used since cleaning. The ordinary artisan thinks in terms of 'use and wont'. To substitute glass for a prior, and what we may justly regard as a more obvious, form of container, and to shield it from sight, except when the stand is turned up for examination, seems to us a patentable step. If the advantages of doing what Fleming accomplished had been already apprehended, the means to attain them would perhaps be too simple to deserve the name of invention, but the apprehension of the labor-saving, convenient, and neat device disclosed in the patent in suit involved more than the work of a routine mind.

. . . . . .

"The claims should be limited to a glass receptacle, and this limitaton may properly be made, where the claims as drawn are too broad, and the invention embodied in the claims is limited as disclosed in the specification. A meritorious invention disclosed in the specification should be saved, in spite of broad claims, by such a limitation. Fowler & Wolfe Mfg. Co. v. McCrum-Howell Co. (C. C. A.) 215 F. 905; Radio Corporation of America v. Twentieth Century Radio Corporation (C. C. A.) 19 F. (2d) 290.

"We accordingly hold the patent valid and infringed."

A similar case is *Mantle Lamp Co. of America v. George H. Bowman Co.*, 53 F. (2d) 441 (C. C. A. 6), wherein it was held, in interpreting the claims for an improved heat

insulating receptacle, that the specifications should be referred to in order to construe the claim for a bond between the two members as meaning a bond made of insulating material.

We therefore conclude that claims 1 and 2 of the patents should be read so as to include therein the plunger described in the specifications, namely, a closely coiled wire tube. So read, the claims are sufficiently narrow to avoid the claim of anticipation and are valid.

(c) Nothing Occurred in the Patent Office Which Prevents Respondent From So Reading These Claims; There Was No Estoppel and No Abandonment of This Essential Feature of the Invention.

The petitioners argue, however, that although ordinarily respondent might be entitled to read claims 1 and 2 so as to call for a closed coil tube as a plunger, he cannot do so in this case because of certain proceedings which took place while the case was going through the Patent Office.

There are two grounds, and two grounds only, upon which it is claimed or can be claimed that respondent is prevented from properly interpreting his claims on account of anything which occurred while the case was going through the Patent Office. The first is that he was estopped by something which he there did from so interpreting claims 1 and 2, and the second is that he abandoned the closely coiled wire plunger as an element of his invention. Neither of these contentions has any validity.

Respondent, in his application as originally filed, presented the drawings and specifications exactly as they appear in the patent, and set forth twenty-six separate claims

which he requested should be allowed. Many of these claims were almost identical and they were far too numerous. The application was filed on February 7, 1918. (See File Wrapper, Defendant's Exhibit No. 1, R., Vol. II, p. 231.)

On February 25, 1918, the Examiner wrote a letter to respondent's attorney in which he allowed claims 23 and 24 and rejected all the rest on certain patents cited, at the same time stating that the claims were excessive in number, "many of them of the same scope and substantially duplicates." Claims 23 and 24 were afterwards numbered 5 and 6 and were ultimately allowed exactly as they now appear in the patent without any intervening rejection or amendment. (File Wrapper, p. 19, R., Vol. II, p. 251.)

By letter dated May 23, 1918, respondent's attorney, replying to the letter of the Examiner, made certain amendments to the claims, some of them mere changes in phraseology, and, with special reference to claim 1 now under consideration, inserted the words "a barrel on the outer head" which now appears in the second and third lines of this claim. In addition, this claim was amended to include the expression "and engaging said barrel," this with reference to the spring casing. No other amendments to claim 1 were made. Similar amendments were made in the other claims, some of which will be more particularly discussed later. (File Wrapper, p. 21, R., Vol. II, p. 253.)

It may be conceded that the action of the applicant in amending claim 1 instead of taking an appeal, as he might have done, would estop him from afterwards asserting a claim without the element added by amendment, or such a construction of his claim as would be equivalent thereto. *Smith v. Magic City Club*, 282 U. S. 784; *Morgan Envelope Co. v. Albany etc. Paper Co.*, 152 U. S. 425, and other cases

cited by petitioner. The same is true of the other amended claims.

It by no means follows, however, that respondent cannot rely upon the rule above referred to permitting him to read into his claim the provisions of the specification.

It is well settled that where a patentee amends his claim after rejection upon a reference to a prior patent, he is not estopped from arguing for the validity of his patent upon any legal grounds, so long as he does not argue that the claim after amendment means the same as before amendment.

In *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. 693, 714, the Circuit Court of Appeals (8th Circuit) said:

> " . . . It is true that if a patentee acquiesces in the rejection of his claim on references cited in the patent office, and accepts a patent on an amended claim, he is thereby estopped from maintaining that the amended claim covers the combinations shown in the references, and from claiming that it has the breadth of the claim that was rejected. [Citing among other cases, Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425, 429]. But this is the limit of the estoppel. One who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references is not thereby estopped from claiming and securing by an amended claim every known and useful improvement which he has invented that is not disclosed by those references."

It may be conceded that the Examiner thought that respondent's claim would not be valid without the inclusion of the barrel, and it may be further conceded that the barrel was not a new element. If, however, the Examiner was

mistaken in believing that the addition of the barrel was necessary to save respondent's claim, and he clearly was, this does not prevent respondent from relying upon the particular combination which he disclosed to sustain the validity of his patent, notwithstanding the Examiner may have been of a different opinion.

It has been held that the statement of an erroneous opinion or conclusion by an Examiner cannot prejudice the right of a patentee. To this effect is the decision in the case of *Godwin Co. v. International Steel Tire Co.*, 2 F. (2d) 198, 199, in which the court said, among other things:

> "The conclusion of the Examiner to grant a particular claim, like the conclusion of an equity trial court to enter a particular decree, will be approved, if it was right, although the reason given is not sound."

It is well settled that whatever the view of the Examiner may have been, respondent, although he is estopped from urging that his claim is broader than that allowed, **is not prevented from relying upon any element or elements in his claim which render it valid.**

In the case of *Godwin Co. v. International Steel Tire Co.*, 2 F. (2d) 198, 199, *supra*, the Circuit Court of Appeals (6th Circuit) said:

> "In its progress through the Patent Office claim 4, with others, was rejected on reference to Freese. It was thereupon amended to include the guard limitation finally found in it, 'extending to the upper edge of the roadway and forming a boundary therefor,' and it was pointed out that the application was distinguished from Freese by this additional limitation. It is said that since there was no invention in this mere limitation or modification, and that since the applicant rested his case

thereon, he cannot now be heard to say that invention may be found elsewhere in, or in connection with, the device.

"The familiar rule of estoppel by Patent Office proceedings is invoked. This rule does not reach the case. The patentee may not later have such a construction of his claim that it will cover the device which has been thus protected by his confession and avoidance; but so long as he does not seek thus to broaden his claim, we do not know of any principle or authority which would bar him from claiming that his device was in fact patentable for other reasons than the one shown by his amendment."

In *Hildreth v. Mastoras*, 257 U. S. 27, this Court held that where one of the claims in a patent application was cancelled on a reference to another patent which on examination by the Court was observed not to anticipate the cancelled claim, such cancellation was of no importance and could not affect the interpretation of other claims. The Court said (p. 33):

"Counsel for the respondent in seeking to narrow the construction of the broad claim of Dickinson rely on the circumstance that one of Dickinson's claims in the Patent Office was cancelled on a reference to Firchau. . . . However, . . . as neither Firchau nor anyone else has shown . . . the fundamental element of the Dickinson invention, the cancellation does not seem to us important or to require a narrowing of Dickinson's claim. . . ."

As nothing so far transpiring in the Patent Office can be invoked to estop respondent from reading into his claims the coiled wire tube described in the specifications, petitioners rely upon further proceedings. At the close of his

letter to the Examiner above noted in which he amended certain of his claims, respondent requested the Examiner to point out which of his claims were considered duplicates and should be eliminated. (File Wrapper, p. 24, R., Vol. II, p. 256.)

Under date of June 15th, the Examiner replied to this letter, allowed, *inter alia,* claims 1 and 4, as amended, of the application, these being claims 1 and 2, respectively, of the patent, and rejected many of the claims as being substantially identical with other claims allowed. This was particularly true of claim 17 upon which petitioners especially rely. The Examiner's action in respect to this claim was in the following words:

> "Claims 17 to 22 are rejected as not patentably distinct from claims 1 and 4 allowed. The use of the 'coiled wire tube' for the 'intervening means' defined in claim 1 is not patentable in view of the German patent of record. In other words—applicant merely adds a limitation found in the prior art—to allowed claims which is not patentable." (File Wrapper, p. 26, R., Vol. II, p. 258.)

To this letter respondent's attorney replied under date of June 17th cancelling certain claims, among them claim 17 and requesting reconsideration of claims 27 and 28. (File Wrapper, p. 27, R., Vol. II, p. 259.) To this letter the Examiner replied under date of July 18th, allowing all of the claims now contained in the patent and rejecting certain others, principally because these latter claims did not patentably differentiate from the claims allowed. These are the only relevant proceedings in the Patent Office. (File Wrapper, p. 28, R., Vol. II, p. 260.)

Petitioners argue, that respondent is estopped from reading into claims 1 and 2 that portion of the specifications

which limited the "means intervening" to a coiled wire tube plunger, because, after claims 1 and 2 were allowed by the Examiner, respondent acquiesced in the rejection of claim 17, which specifically defined the intervening means, as in substance identical with claims 1 and 2 and therefore superfluous.

It is respectfully submitted that this conclusion is untenable and is unsustained by authority. A case of estoppel has not been made out. The theory of estoppel arising out of proceedings in the Patent Office is that an applicant, having accepted an amendment to his claim, **in order to get another**, or **who has accepted cancellation of one claim in order that another may be granted**, is estopped from contending thereafter that the amended claim has the same meaning as it had before it was amended, or that the granted claim has the same meaning as the cancelled claim.

All of this, however, is dependent upon a change of position by the Examiner; upon a bargain between applicant and the Examiner whereby the Examiner gives something to the applicant in consideration of an amendment or cancellation, as the case may be.

But no such doctrine can be relied upon where, as here, nothing of the sort took place.

Respondent's **claims 1 and 2 had already been allowed** before the Examiner advised respondent that he considered claim 17 substantially identical with claims 1 and 2 and therefore superfluous. It is plain that **the allowance of claims 1 and 2, was not made conditional upon the cancellation of claim 17.**

As was held in the cases of *Bundy Mfg. Co. v. Detroit Time-Register Co.*, 94 Fed. 524, 543, and *Frey v. Marvel Auto Supply Co.*, 236 Fed. 916, 921, 922:

> " . . . to be estopped by the action of the Patent Office, a patentee must be shown to have surrendered something which he now claims in order to obtain that which was allowed."

In all of the cases cited by the petitioners in their brief, it was distinctly held that estoppel arises as the result of the applicant's revision of a claim **in order to get a patent.**

Thus, in *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U. S. 668, 677, this Court said:

> ". . . Having thus narrowed his claim against rotary movement in order to obtain a patent, the patentee may not by construction . . . give to the claim the larger scope. . . ."

Also, in *I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 443, the Court said:

> ". . . If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it."

See also *Smith v. Magic City Club*, 282 U. S. 784.

In *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, particularly relied upon by the petitioners, it appeared that applicant had presented a claim in a narrow form, and the same having been rejected by the Patent Office, he thereafter presented it in a broader form and the same was allowed. The Court observed (p. 429):

> "Why the claim of the present patent was allowed after the rejection of the narrower claim does not appear."

And, indeed, it would be almost impossible to imagine a reason why it should have been. But the sentence quoted

above from the opinion of the court shows clearly that **the narrower claim was first presented and rejected,** and in view of such rejection a broader claim **was thereafter submitted and allowed.** The one was substituted for the other. This was, therefore, a case in which the rule of estoppel was properly applied, although the point was not necessary to the decision of the court.

In the case at bar, however, claims 1 and 2 were allowed before the Examiner directed the erasure of claim 17; therefore they were not allowed in substitution for claim 17 and there can be no estoppel.

Moreover, it has been held that the cancellation of a claim in an application for a patent because it is substantially identical with a remaining claim does not affect the validity of the latter. In the case of *Kryptok Co. v. Stead Lens Co.*, 207 Fed. 85, 89 (affirmed 214 Fed. 368, C. C. A. 8), the Court said:

> ". . . defendant insists that the cancellation of claim 3 in response to this objection limited and narrowed original claim 1, now the contested claim of the first patent in suit. . . .
>
> "A comparison of this claim with the remaining claim of the first patent in suit, heretofore quoted, will disclose that in all particulars substantial to this controversy they are the same. This being true, the cancellation of the superfluous third claim, substantially identical with the first, would not affect the latter. Bullock Elec. Mfg. Co. v. Crocker-Wheeler Co. (C. C.), 141 Fed. 101, 110."

It is argued by petitioners that because the examiner said in his letter to applicant that

> "the use of the 'coiled wire tube' for the 'intervening means,' defined in claim 1 is not patentable in view of the German patent of record"

a direct issue was raised between the applicant and the Patent Office as to whether the use of such coiled wire tube was or was not patentable.

In the first place it should be pointed out that such an expression of opinion by the examiner, where there is admittedly no estoppel, is of no importance whatever, and will not be considered by the court in determining the meaning of the patent after it has been granted.

In *Campbell Metal Window Corp. v. S. H. Pomeroy & Co.*, 300 Fed. 872, 874 (S. D. N. Y.), Learned Hand (D. J.) said:

> ". . . I do not understand that this case [referring to Goodyear, etc., Co. v. Davis, 102 U. S. 222] meant to require me to go through all that was said in the endless communications between applicant and Examiners to gather piecemeal the intent of the grant, as though I were construing a correspondence. If so, what is the purpose of the final formal instrument? . . . In any event, it is well settled by authorities binding upon me that in this circuit we do not look to such exterior expression of intent, but treat a patent as we should a will, a deed, or any other instrument intended to be a final memorial of the parties' intention [citing cases.]"

In *Westinghouse Elec. Co. v. Condit Mfg. Co.*, 194 Fed. 427, 430 (C. C. A. 2), the Court said:

> ". . . But, as a general rule, the interpretation to be placed upon the claims and specification of a patent is to be determined from the language of the grant, and the proceedings in the Patent Office are quite immaterial. Such is the situation in the present case. Original claims were rejected in the Patent Office. Thereupon the applicants, instead of limiting their claims, substituted broader ones which were ac-

cepted. Presumably the examiner changed his mind. But, whatever be the explanation of his position, nothing whatever is shown to work an estoppel against the patentees. Instead of surrendering something which they now claim to obtain that which was allowed, they claimed something more and got it."

But assuming for the moment that the remark is of importance, it did not, as petitioners argue, raise an issue whether the substitution of a coiled wire tube plunger for a straight wire, in the combination, was patentable.

The statement of the examiner was that the use of the coiled wire tube **was not in itself patentable**, and he therefore erroneously concluded that, added to the elements defined in claim 1 without reference to the specifications, it was mere surplusage and did not change the claim substantially. **This must be so** because he found that claim 17 was in substance identical with claim 1, and therefore should be erased as superfluous.

This was no more than a re-assertion of the examiner's opinion earlier expressed, that neither claim 1 nor claim 17 was valid without the addition of the barrel, but that with the barrel both were valid and were in substance the same. In this, as we have seen, the examiner was in error. But that does not prevent respondent from establishing the validity of his claim by referring to the specifications.

The argument of petitioners when carefully analyzed does not make sense. If claim 17 was rejected on the theory which petitioners have advanced, that the claim in its narrowed form was anticipated by an earlier patent, certainly claim 1 should also have been rejected for in its broader form or when narrowed by reference to the specification it would also most certainly be anticipated.

Petitioners assert that there was directly raised between the applicant and the examiner the question whether a coiled wire tube as a plunger could be included in the claim, because the examiner stated that it had been anticipated by the Wermann patent and was of itself not patentable. But this would not be a sensible objection to granting this claim, since he had already granted a claim broader in terms than this (but which by reference to the specifications would be identical), which therefore necessarily must also have been anticipated by the Wermann patent as well as others.

Logic must therefore reject the argument of petitioners that the direction to respondent to erase claim 17 involved a ruling that a coiled wire tube could not be included because anticipated by Wermann and that respondent's failure to protest was an acceptance of this view. His erasure of the claim was a mere acceptance of the examiner's ruling that it was in substance the same as claims 1 and 2 and was superfluous.

Finally petitioners advance a specious argument based on *United States Repair & Guarantee Co. v. Assyrian Asphalt Co.*, 183 U. S. 591, that respondent abandoned the coiled wire tube as a plunger by the cancellation of claim 17. This argument impressed the district court and he adopted it in his decision.

In the Assyrian Asphalt case plaintiff had procured a patent for a method of repairing asphalt pavements. The specification of the patent described the method merely as requiring the application of heat to the spot to be repaired in such a way as to soften the edges and enable the repair to be made in such fashion that the new portion would be firmly welded to the old. A form of apparatus was de-

scribed which included burners for projecting a strong blast of heat against the surface of the asphalt but the patentee expressly stated that:

> ". . . The heating of the surface may be accomplished in various ways and by means of various forms of apparatus, and while I have herein shown but one form for accomplishing the result, yet I would have it understood that I do not limit myself to any particular form of apparatus for carrying out my invention" (p. 593).

The claim asserted to be infringed was as follows:

> "1. The method of repairing asphalt pavements, which consists in subjecting the spot to be repaired to heat, adding new material and smoothing and burnishing it, substantially as described" (p. 594).

A third claim, containing the limitation "a blast of heat," in lieu of the unqualified word "heat," had been withdrawn by the patentee upon a ruling of the Patent Office that the first and third claims were the same in substance and could not both be permitted in the same case.

This Court held that a prior French patent completely anticipated the method of plaintiff, if it was construed broadly to mean merely the application of heat to the spot to be repaired. Plaintiff thereupon argued that his claim should be limited to a special method of applying the heat in the form of a blast, as it was applied by his burner. It is obvious without discussion that this construction was impossible. There was not a line in the patent or the specifications which suggested that the invention or the claim was limited to that particular method of applying heat, and this Court said (p. 594):

> ". . . considering the language of the claim and of the specifications, it seems impossible to escape the

> conclusion that the invention claimed is for the application of heat to the spot to be repaired. And the patentee did not confine himself to the particular apparatus he described. That, he said, was 'one form of accomplishing the result.' "

This completely disposed of the case. The patentee had not obtained a patent for a method involving a blast of heat. There was no suggestion anywhere in his specifications that this was the case, and therefore necessarily he was out of court.

The Court, however, at the conclusion of its opinion, used certain language which was paraphrased by the district court as defeating the claim of respondent in this case. It appeared that the Patent Office had ruled that "the first and third claims were the same in substance and could not both be permitted to remain in the case." In view of this ruling, this Court quoted with approval the language of the Court of Appeals as follows (p. 601):

> "Having voluntarily abandoned the claim for a method limited to the use of 'a blast of heat,' the patentee or his assignee may not now insist that a broad claim, containing no suggestion of such intention, shall nevertheless be subjected by construction to the same restriction."

It will be observed that the conclusion of the Court was that the patentee had "voluntarily abandoned" his claim for a method based on the use of a "blast of heat," and this in turn was based upon the fact that, as the Court expressed it, there was "no suggestion" in the other claims or in the specifications of an intention to limit his method to a blast of heat. The applicant had therefore **given up the only claim which could possibly be construed to be limited**

to a blast of heat, and the Court held this was an abandonment.

In the case at bar it cannot be argued that the action of the plaintiff in cancelling claim 17, after the Examiner had stated that it was in substance identical with claims 1 and 2, **already allowed**, was an abandonment of a claim for a coiled wire tube as the intervening means, for the reason that the coiled wire tube as the means intended is clearly described, and is the only means described, in the specifications, and the coiled wire tube so described remained in the patent. Other remaining claims 5 and 6 describe it specifically.

Nowhere in this patent is there any suggestion that the applicant had any other intervening means in mind, and he made no attempt to claim any other. There was therefore no abandonment.

Attention is called to the fact that in the Assyrian Asphalt case it appears from the opinion of the Court, above quoted, that the applicant was required to elect between claims 1 and 3, the first of which was broad in form and the second narrower, and that he chose to accept the first and reject the second. If the first had, as in the case at bar, referred to the specifications for a description of the method, and that description had shown that the only method intended to be used involved a blast of heat, the decision would have been different.

As it stands, however, and as is clearly disclosed in the opinion of this Court, applicant was required to elect. Claim 1 was not susceptible of being construed as limited to a blast of heat; claim 3 was so limited, and the claimant chose to abandon the limited claim and to accept the broad claim. It is submitted that this case cannot control the case at bar.

It may not be improper to add that this Court in making its decision said (p. 601):

> "This point, in view of the reservation already considered, is unimportant and might be passed."

It is respectfully concluded on this branch of the case, therefore, that there is nothing in the proceedings in the Patent Office which precludes the plaintiff from referring to the specifications to construe and narrow claims 1 and 2, thereby rendering them valid.

4. THE CONTENTION MADE IN PETITIONERS' BRIEF THAT THEY HAD CONCEIVED OF RESPONDENT'S DEVICE BEFORE HE DISCLOSED IT TO THEM IS IMMATERIAL TO THIS APPEAL, BUT THE ADMITTED FACTS DO NOT SUSTAIN THIS CONCLUSION.

Toward the end of their brief, petitioners, although admitting its immateriality to this appeal, allege (p. 42)

> "that the Eastman Company did not acquire knowledge of the accused releases from Gray".

There is not, and never was, any claim that the Eastman Company had devised respondent's device prior to his filing date. The allegations contained in the brief, therefore, relate only to the question of damages, not now in issue, but we think it desirable in the interest of accuracy to point out that they are not correct.

The record shows that on July 2, 1918, respondent sent to petitioners a sample of his release, for which an application for a patent was then pending. This is admitted in petitioners' brief, page 42. A little more than a week later,

this release was returned to respondent, having been cut open and examined; (See respondent's physical exhibit No. 8, a box containing this release).

With the release there was sent by petitioners to respondent a letter (R., Vol. II, p. 215) in which it was said:

> "... We find that this release is identical in practically every respect with the release which we have been marketing for some time."

and

> "Inasmuch as you mention having the matter of organizing a Company to market this device in your mind, it might interest you to know that we are perfecting our patents covering this construction."

Neither of these statements was true. The release which petitioners had been marketing prior to that date was the Dakin release covered by the Dakin patent (R., Vol. II, p. 298), which called for a **closed coil** spring outer tube whereas the improvement devised by respondent involved the use of an open coil tube. It was the Dakin device for which a patent had been applied for by petitioners; this was granted nearly a year later, i. e., March 18, 1919 (R., Vol. II, p. 300). Petitioners never applied for a patent on respondent's device or one similar thereto.

Petitioners argue, based on a number of mutilated papers taken from their records, that they were experimenting with the type of release covered by respondent's patent prior to the date of his disclosure to them (Petitioners' Brief, pp. 42-44). The papers upon which they rely are so-called lists of parts, being in effect specifications for the manufacture of releases. They appear in the record, Vol. II, pp. 274-280 inclusive;

all bear evidence of change and mutilation, and all except one were cancelled and discarded prior to respondent's disclosure. That one, not marked as cancelled and discarded (R., Vol. II, p. 275) shows on its face that when originally made "5/27/18", it called for a spring casing or outer tube according to drawing 9507, which is a closed coil spring casing in accordance with the Dakin patent (R., Vol. II, p. 225). The change from this drawing to drawing 15131, showing a spring casing, with an open coil, such as is used in respondent's release (R., Vol. II, p. 226) was evidently made at the date stamped at the bottom of this paper—"Apr. 12, 1920"; this was approximately the date that the manufacture of the respondent's device began in petitioners' plant (R., pp. 93-98).

It is difficult to see how petitioners can seriously argue that they knew of or had used respondent's device prior to his disclosure to them, in view of the letters they wrote him when he charged them with infringing his patent.

We refer the Court to a letter of Mr. Lovejoy, Vice-President of the Eastman Kodak Company, to respondent's representative, dated December 2, 1919 (R., Vol. II, p. 218), in which he says:

> ". . . The cable release which you sent us with your letter to Mr. Fell of June 21, 1918, was like a cable release which we had marketed many years previously, except in two features: First, the coils of the flexible casing were open, or separated, so as to give a spring effect; second, the inner thrust member, instead of being composed of twisted strands, was itself a miniature coiled tube."

The writer then goes on to say that they were familiar with both these features but made no claim that they were

familiar with any construction which combined them together. On the contrary, the letter is an express admission that this combination was new.

On October 31, 1923, Mr. Chapman, of the Eastman Kodak Company, wrote another letter to respondent (R., Vol. II, p. 220), in which, referring to the sample which had been sent them by respondent in 1918, he said:

> " . . . This cable release we found to be similar to cable releases which we had made and marketed for several years except for two features, both of which were not original with you. First, the flexible casing included an open coil spring, and second, the plunger of the cable release consisted of a closed coil spring."

Then, after referring to earlier patents, all of which have been discussed in this case, the writer continued (R., Vol. II, p. 221):

> "We feel that the circumstances outlined above furnish convincing evidence that the cable release which you submitted to us differed from those which we had had on the market for years only in these two ways, and that cable releases embodying the construction constituting these two differences are clearly shown in the prior art."

The writer of this letter, like Mr. Lovejoy, expressly admitted that respondent's combination was new, although claiming that the elements thereof (as is conceded) were old.

In the face of these letters, it is impossible for petitioners to argue with any conviction that they knew of respondent's type of release before he disclosed it to them. The release with which they were experimenting involved other combinations of these elements, either a straight wire

plunger or a combination of a closed coil plunger with a closed coil spring casing or outer tube.

The discussion regarding the question whether or not the Edwards patent would be infringed, if shipment were made to Europe (Petitioners' Brief, p. 44) related entirely to the use of a cable release consisting of an open coil spring casing and a straight wire plunger or thrust member.

As above noted all this is immaterial to the present appeal, but we could not allow the unfounded assertions made in the petitioners' brief, that respondent contributed nothing to their knowledge of the art, to go unchallenged.

CONCLUSION.

We therefore submit in conclusion—

1. The case was submitted to the district court for its decision upon a record already made up, consisting of facts either agreed upon or proven by undisputed evidence.

2. These included the ultimate facts necessary for a decision of the case, leaving to the court only the function of drawing conclusions by the application of legal principles to these facts.

3. The Court of Appeals correctly held that it had jurisdiction to review the record of the district court, to ascertain whether the judgment was supported by the underlying and undisputed facts.

4. The reasons averred in the petition for a writ of certiorari in this case, having been shown on further examination to have no existence, and in view of the fact that there was no final decision in the court below, the writ should now be dismissed without examination into the merits of the case.

5. The Court of Appeals correctly found that the judgment of the district court was not supported by the undisputed facts shown by the record and the judgment should be affirmed.

Respectfully submitted,

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